

REMARKS

Claims 2-9 are pending in the present Application. Claim 9 has been canceled, claims 2, 6, and 7 have been amended, and no claims have been added, leaving Claims 2-8 for consideration upon entry of the present Amendment.

Claim 2 has been amended to further define the invention as discussed in detail below. Support for the amendments to Claim 2 subparts i-iii can be found in the Specification at least on p. 3, lines 18-20; p. 5, lines 1-2; p. 6, lines 10-12 and 16-17; and support for the amendments to subparts a-d can be found in the Specification on p. 8, line 20, p. 9, line 1, and p. 12, lines 3-7. In addition, Claim 2 has been amended to correct inadvertent typographical errors, and to include the limitations of dependent claim 9. Accordingly, Claim 9 is canceled upon entry of the present amendment.

Claim 6 has been amended to further define the invention as discussed in detail below. Support for the amendments to Claim 6 can be found in the Specification on p. 7, lines 2-3.

No new matter has been introduced by these amendments. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 2-9 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, according to the Examiner, Claims 2 and 6 are indefinite for using weight percentage in a manner contrary to its usual and customary form. Accordingly, Claim 2 has been amended to clearly show that the claimed weight percentages of components i-iii in the magnetic toner particle are based on the overall amount of magnetic toner particle, and hence can total no more than 100 wt% of the magnetic toner particle. The amounts of components a-d in Claim 2 have been amended to correctly show that the components b-d are present in parts by weight, relative to 100 parts by weight of component a) (the magnetic toner particle), and the use of wt% in describing the amounts of these components is inadvertent typographical error. In addition, in Claim 6, the relative amount of

release agent relative to the binder has also been amended to clearly and correctly express the relationship as parts by weight of release agent per 100 parts by weight of binder. The rejection of Claim 9 is now moot with its cancellation upon entry of this Amendment. Applicants apologize for these inadvertent typographical errors, and believe the foregoing amendments will be found by the Examiner to be fully responsive to the concerns advanced, and that the recited limitations should now be acceptable. Reconsideration and withdrawal of the rejection is respectfully requested.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 2, 3, and 5-9 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 6,287,739 ("Kawakami"). Applicants respectfully traverse this rejection.

Kawakami discloses a toner having toner particles of silica and alumina of different surface areas. Col. 2, lines 45-53.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Kawakami thus discloses a toner including two types of hydrophobic silica fine particles. However, Kawakami fails to disclose or teach a toner composition including the metal oxide fine powder of titanium dioxide, zinc oxide, magnesium oxide, cerium oxide, iron oxide, copper oxide, and tin oxide, as claimed in amended Claim 2. Further, Kawakami discloses fine alumina particles as a further external additive for preventing a decrease in image density or uneven images ascribable to the charge-up of toner in an environment of low humidity. See Col. 7, lines 34 to 52; Col. 25, Table 1. The instant claims as amended do not claim alumina. Kawakami thus fails to disclose or teach all elements of the instant claims, and thus does not render unpatentable the instant claims. Reconsideration and allowance of the instant claims are respectfully requested.

Claims 2, 3, and 5-9 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 6,287,739 ("Kawakami") in view of *Handbook of Imaging Materials* (2nd edition), Diamond et.al., pp. 178-182 ("Diamond"). Applicants respectfully traverse this

rejection.

Also for establishing a *prima facie* case of obviousness, the Examiner must show that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Diamond discloses surface additives including silicas and titanias. See p. 181, section 5.2.4. However, Kawakami and Diamond each fail to teach or disclose an amount of the metal oxide fine powder claimed in amended Claim 2. In addition, Diamond fails to teach or disclose use of zinc oxide, magnesium oxide, cerium oxide, iron oxide, copper oxide, and tin oxide, as claimed in amended Claim 2. Thus, the combination of Kawakami with Diamond each fail to teach or disclose all elements of the instant claim and thus does not render unpatentable the instant claims. Reconsideration and allowance of the instant claims are respectfully requested.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

CANTOR COLBURN LLP

By /Dana A. Gronbeck/
Dana. A. Gronbeck
Registration No. 55,226
Confirmation No. 9136
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002
Telephone (860) 286-2929
Facsimile (860) 286-0115
Customer No.: 23413

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